

Remarks

In view of the following remarks, favorable reconsideration of the outstanding final office action is respectfully requested. Claims 1 – 23 and 25 – 40 remain in this application. Claim 24 has been canceled.

**1. Allowed Claims/Subject Matter**

Applicant notes with appreciation that the Examiner has indicated the subject matter of claims 22 and 26 – 32 is patentable, and would be allowable if rewritten in independent form.

**2. § 102 Rejections**

A. U.S. Patent No. 5,525,908 to Brownell

The Examiner has rejected claims 1- 10, 19 – 21, 25, and 33 – 39 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,525,908 to Brownell.

Brownell is directed to an electrical outlet wiring analyzer that includes generator circuitry for periodically providing an alternating current pulse of one cycle at a frequency of an alternating current voltage supplied by an electrical outlet having a plurality of conductors. The wiring analyzer also includes connecting circuitry for electrically applying the alternating current pulse to at least one of the conductors and circuitry for determining an impedance of each of the conductors to which the alternating current pulse is applied.

According to MPEP 2131, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

***Response to Examiner's Arguments***

1. Independent claim 1

In the first Office Action, the Examiner asserted that Brownell’s Figure 15 shows a “circuit status indicator assembly coupled to the fault detection circuit and normal thereto,”

as recited in claim 1. The applicants pointed out that the Examiner was using Figure 15 to cover two elements in claim 1. The examiner asserted that Figure 15 was both a housing and a circuit status indicator assembly. This is improper.

In response, the Examiner now argues that “*the semiconductor light indicators are shown in fig. 15 as 124, 126 and 128 as part of the circuit status indicator assembly which also includes display panel 122.*” Applicant makes several points in response. The examiner continues to improperly read an element out of the claim. Figure 15 shows the plan view of one side of the entire device. Figure 15 simply does not show separate assemblies within the device. The device as shown in Figure 15 and Figure 16 is a black box. On the other hand, the present application shows explicitly (See Figure 4) the mechanical relationship between the elements of the device. Claim 1 is directed, in part, to that relationship which is not disclosed or anticipated by Brownell.

Furthermore, claim 1 is directed to “*an electric circuit test device...comprising...at least one circuit status indicator assembly coupled to the fault detection circuit and normal thereto...*” Applicants respectfully submit that Brownell does not disclose the subject matter recited in claim 1 because the examiner does not show where Brownell includes both a fault detection circuit and a circuit status indicator assembly arranged perpendicularly with respect to each other as the claim recites. In other words, referring to Figures 9, 14, 15, and 16, Brownell teaches a black-box and does not show the mechanical implementation of the interior of that box. The schematic of Figure 14 merely shows the electrical relationships between the components of the circuit, but does not show how the circuit is implemented mechanically. As such, the examiner does not show, indeed cannot show, where Brownell discloses *at least one circuit status indicator assembly coupled to the fault detection circuit and normal thereto*, as recited in claim 1.

The examiner also fails to show where Brownell discloses light elements normal to, i.e., perpendicular to, both the at least one circuit status indicator and the longitudinal axis, as recited in claim 1.

Accordingly, the Examiner does not show where each and every element as set forth in the claim is found in the Brownell reference. As such, the Examiner does not make a *prima facie* case of anticipation with regard to claim 1.

Dependent claims 2 - 23

While the dependent claims are patentable by virtue of their dependency from claim 1, claims 2 – 23 are patentable in their own right.

The examiner's rejection of claim 8 and claim 9 is improper because he substitutes his own definition for "mis-wire" in place of applicants definition of "mis-wire." The applicant is entitled be his own lexicographer, not the examiner. The cited text (Col. 12, lines 7 – 11) makes absolutely no mention of miswire detection, it appears to refer to an under-voltage condition. Accordingly, the Examiner does not show where Brownell anticipates either claim 8 or claim 9.

The Examiner's argument with regard to claim 10 is outrageous. For Brownell's Figure 12 to anticipate claim 10, it must support all of the recited voltages including 120 VAC, 277 VAC, or 347 VAC. The word "or" is used, because only one voltage, by definition, is present on the line at a time. In other words, the rated voltage is either 120 VAC, 277 VAC, or 347 VAC. Just because the word "or" is used in the claim, it does not mean that the Examiner can assert a reference that only meets one of the three voltages. Figure 12 only shows a 120 VAC rating. As such, the Examiner does not show where Brownell discloses the subject matter of claim 10.

The examiner's arguments with regard to the subject matter of claim 20 merely repeats the claim language. The examiner fails to point to any standoff structure in Brownell. Figure 15 simply does not show any of the recited *standoff elements*. Figure 15 only shows a plan view of a panel. On the other hand, the term "standoff element" is defined in the specification and shown in the Figures. Once again, the Examiner is attempting to redefine terms that were defined by the applicant in the specification. This is improper.

Independent claim 25:

The examiner does not respond to the applicants arguments presented in the last response. Instead, the examiner provides a new rationale for his rejection. The examiner argues that the lights L1 – L3 are part of the “circuit status indicator assembly shown in Figure 2.” However, the ‘908 patent refers to Figure 2 as the *schematic of the wiring analyzer shown in Figure 1*. The examiner then argues that the schematic shown in Figure 2 includes display panel 58 in Figure 9. The examiner then states that Figure 9 may be replaced by Figure 10. Applicants respectfully point out that reference element 58 is not shown in Figure 2. Even if it were, it is irrelevant because the claim recites *at least one circuit status indicator assembly normal to the fault detection circuit*. Neither Figure 2, nor Figure 9, nor Figure 10 show any such spatial relationship – i.e., at least one circuit status indicator assembly normal to the fault detection circuit. Figure 2 shows one schematic, it does not show the spatial relationship between two assemblies. Figure 9 and Figure 10 do not remedy this deficiency.

The Examiner then argues that Brownell anticipates claim 25 because the semiconductor lights (1 – 3) in Figure 10 are allegedly normal to the panel. However, the claim recites the spatial relationship between a fault detection circuit (which the Examiner fails to identify in Brownell) and a circuit status indicator assembly (which the Examiner also fails to identify in Brownell) and semiconductor light indicators. In particular, the claim recites *at least one circuit status indicator assembly normal to the fault detection circuit...and a plurality of semiconductor light indicators connected normal to the at least one circuit status indicator assembly*. Neither Figure 2, Figure 9, nor Figure 10, whether taken alone or together, anticipate the recited claim language. The applicants respectfully point out that the Examiner’s rejection is entirely out of context and ignores the recited claim limitations.

Dependent claims 26 - 41

While the dependent claims are patentable by virtue of their dependency from claim 25, the dependent claims are patentable in their own right.

With regard to claim 39, the Examiner again asserts that Brownell discloses a device that supports 120 VAC, 277 VAC, or 347 VAC. However, as noted above, Brownell only shows a device that supports 120 VAC. Accordingly, the Examiner does not show where Brownell discloses the subject matter of claim 39.

The Examiner has not made a *prima facie* case of anticipation because he has not shown where Brownell discloses each and every element of the claimed invention. Accordingly claims 1- 10, 19 – 21, 25, and 33 – 39 are patentable under 35 U.S.C. § 102(b). The applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

**B. U.S. Patent No. 3,922,600 to Roveti:**

The Examiner has rejected claims 1, 13 – 18, and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,922,600 to Roveti.

Roveti is directed to a device for performing a plurality of tests upon an electrical power receptacle. The device includes a housing that has pair of blades protruding from it. Signal lights indicate the proper wiring of the receptacle contacts and the effectiveness of the grounding contact.

***Response to Examiner's Arguments***

**Independent claim 1:**

With regard to claim 1, the Examiner has failed to make a *prima facie* case of anticipation because he fails to point out where each and every element of the claimed invention can be found in the Roveti reference. The Examiner's rejection glosses over the fine points by parroting back the claim language without saying where Figure 4 shows both a fault detection circuit AND a circuit status indicator assembly. Figure 4 shows a schematic. It does not show any of the spatial relationships and/or functional relationships between the elements recited in claim 1.

The applicants also point out that the examiner's *Response to Arguments* employs flawed logic. The examiner states that "*the circuit status indicator assembly is made up of signal lights 23 – 25...therefore the signal lights are normal to the circuit status indicator assembly.*" The flaw in the examiner's argument becomes apparent when the examiner attempts to apply his logic to the spatial arrangement recited in the claim. The examiner first

argues that the “*circuit indicator assembly* is made up of the *signal lights*.” In other words, the examiner argues that the signal lights and the indicator assembly are one and the same, i.e., there is one thing. He does this to get around the stubborn fact that the claim recites two separate elements, whereas Roveti only shows one. The examiner then ignores the fact that he previously argued that the two elements were one and the same and separates them out again by arguing that they are normal to each other. If, as the examiner first argues, the lights and the assembly are the same, the examiner must explain how something can be disposed normal to itself. If, the lights and the assembly are two different things, then the examiner must point out where Roveti shows both. The examiner cannot have it both ways. This is improper.

The examiner also fails to show where Roveti discloses light elements normal to, i.e., perpendicular to, the at least one circuit status indicator and the longitudinal axis, as recited in claim 1. Applicants note that Figure 3 shows lights 23, 24, 25 disposed parallel to the longitudinal axis.

Accordingly, the examiner has failed to make a *prima facie* case of anticipation.

#### Dependent Claims 13 – 18 and 24

While the dependent claims are patentable by virtue of their dependency from claim 1, these claims are patentable in their own right.

The Examiner asserts that column 4, lines 45 – 51 of Roveti disclose a “fault detection circuit configured to detect the circuit status condition in a multi-phase center grounded electric circuit,” as recited in claim 13 and claim 24. The applicants pointed out in their last response that the cited text provides a tutorial regarding the electrical systems used in the United States. The passage does not discuss Roveti’s invention. The Examiner now argues that Roveti is merely giving examples of electrical systems in which the tester will work. The examiner then cites col. 4, lines 53 – 54, which references Figure 4. However, the cited text does not say anything at all about multi-phase center grounded circuits, nor does Figure 4 show multi-phase circuits. It refers to a hot blade, a neutral blade and a ground. Multi-phase systems require multiple hot lines. Accordingly, the Examiner does not show where Roveti

discloses the subject matter of claim 13 or claim 24.

The Examiner has not made a *prima facie* case of anticipation because he has not shown where Roveti discloses each and every element of the claimed invention. Accordingly claims 1, 13 – 18, and 24 are patentable under 35 U.S.C. § 102(b). The applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

### **3. § 103 Rejections**

The Examiner rejected claims 11, 12, and 40 under 35 U.S.C. § 103 as being unpatentable for obviousness over Brownell in view of U.S. Patent No. 5,065,104 to Kusko et al. (hereinafter Kusko). The Examiner rejected claim 23 under 35 U.S.C. § 103 as being unpatentable for obviousness over Brownell in view of U.S. Patent No. 6,657,435 to Brown.

Applicants made several arguments regarding the examiner's rejection under 35 U.S.C. § 103 in the last response. The examiner did not bother to answer applicants' arguments. The examiner is required to answer applicants' arguments. Accordingly, the applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn. Claims 11, 12, 23, and 40 are patentable under 35 U.S.C. § 103 (a).

#### **4. Conclusion**

Based upon the remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 23 and 25 – 40 and a prompt Notice of Allowance thereon.

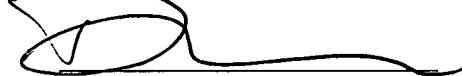
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

BOND, SCHOENECK & KING, PLLC

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Daniel P. Malley  
Registration No. 43,443  
BOND, SCHOENECK & KING, PLLC  
10 Brown Rd.  
Suite 201  
Ithaca, NY 14850-1248